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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,617	09/14/2000	Jeffrey J. Spiegelman	7184-PA10	9556
21005	7590	06/02/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			SINES, BRIAN J	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/661,617

Examiner

Brian J. Sines

Applicant(s)

SPIEGELMAN, JEFFREY J.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

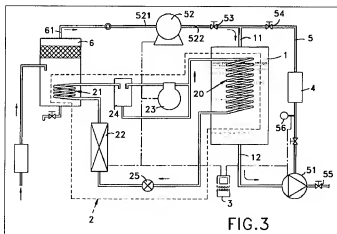
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. Pat. No. 5,873,263 A) in view of Hanson *et al.* (U.S. Pat. No. 5,315,521 A), and further in view of Beelitz *et al.* (U.S. Pat. No. 6,182,275 B1). Regarding claims 1, 14 and 28, Chang teaches a fluid purification system, which comprises various types of equipment, such as a filter device (4), a transfer pump (51), a piping system (5), various sensors (56), a cooling vessel (1), a distillation device (6), *etc.* (see col. 3, lines 27 – 67; col. 4, lines 1 – 16; & figures 3 – 5). Chang does not specifically teach the optimization of the disclosed system. However, the optimization of fluid purification systems through process equipment selection and operation is notoriously well known in the art, as evidenced, for example, by Hanson *et al.* (see col. 1, lines 55 – 67). Therefore, it would have been obvious to one of ordinary skill in the art to optimize the

fluid purification system, as taught by Chang, through the use of optimization techniques well known in the art, in order to facilitate the efficient and effective operation of the fluid purification system.



Chang does not specifically teach a method for identifying fluid purification equipment, which is optimized for use in a particular fluid purification system, wherein the method comprises the steps of: providing a relational database of equipment specifications regarding a plurality of equipment components from which a selection of individual components may be made; providing access to the relational database through an interactive interface of an operating system comprising a series of sequential inquiries, wherein the response to each determines the next type of inquiry to be posed or a component to be specified, wherein the inquiries elicit defining information regarding the particular fluid purification system; and using the defining information to identify those equipment components specific to the particular fluid purification system selected, can be operated so as to optimize the selected fluid purification system.

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However, Beelitz *et al.* teach a method incorporating the use of a computer system readable relational database and an interactive user interface in configuring, building and selling a customizable computer system (see col. 2, lines 20 – 67; col. 3, lines 32 – 43; & col. 4, lines 5 – 62). **The Courts have held that “[a] reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the subject matter with which it deals logically would have commended itself to an inventor’s attention in considering his problem.”** (emphasis added). See *In re Clay*, 23 USPQ2d 1058 (CAFC 1992); & *In re GPAC, Inc.*, 35 USPQ2d 1116 (Fed. Cir. 1995). **If a reference disclosure relates to the same problem as that addressed by the claimed invention, “that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention.”** *Id.* (emphasis added). The Beelitz *et al.* reference relates effectively to the same problem and solution as that addressed by the claimed invention. Hence, one of ordinary skill in the art would have recognized the suitability of applying the same or similar method, as disclosed by Beelitz *et al.*, incorporating the use of relational databases and an interactive interface, for the same intended purpose of configuring, building and selling a similarly customizable product, such as a fluid purification system, as taught by Chang (see MPEP § 2144.07). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success in applying the methodology, as taught by Beelitz *et al.*, in the configuring and selling of a customizable fluid purification system (see MPEP § 2143.02). The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the Courts have held that to

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provide an automatic or mechanical means to replace manual activity, which accomplishes the same result, is within the ambit of one of ordinary skill in the art. See *In re Venner*, 120 USPQ 192 (CCPA 1958). The use of such a computer system-based method, as taught by Chang in view of Beelitz *et al.*, merely substitutes or replaces a manual methodology of consulting print references, such as operating manuals or equipment catalogs, in process design and optimization, which are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide a method for identifying fluid purification equipment, which is optimized for use in a particular fluid purification system, wherein the method comprises the steps of: providing a relational database of equipment specifications regarding a plurality of equipment components from which a selection of individual components may be made; providing access to the relational database through an interactive interface of an operating system comprising a series of sequential inquiries, wherein the response to each determines the next type of inquiry to be posed or a component to be specified, wherein the inquiries elicit defining information regarding the particular fluid purification system; and using the defining information to identify those equipment components specific to the particular fluid purification system selected, can be operated so as to optimize the selected fluid purification system, in order to provide an effective method for identifying fluid purification equipment for an optimized fluid purification system. It would have been obvious to one of ordinary skill in the art to incorporate within the method further inquiries, which elicit defining information regarding the operating parameters of the fluid purification system, as such information would be necessary in order to optimize the system effectively, as is well known in the art. Regarding claim 3, it would have been obvious to one of ordinary skill in the art to incorporate the selection of equipment operating parameters, such as

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fluid type and flow rate, as such information would be necessary in order to optimize the system effectively, as is well known in the art. Regarding claims 4 and 5, Beelitz *et al.* teach that a first database or first list of options comprises a plurality of subdatabases or a second list of options, wherein each of the second plurality of options is compatible with the first selected option choice (see col. 2, lines 20 – 67). Therefore, in applying the method of Beelitz *et al.*, it would have been obvious to one of ordinary skill in the art to provide a subdatabase comprising selection information regarding at least one property of at least one of the equipment components of the fluid purification system in order to facilitate operational compatibility of the equipment components comprising the fluid purification system and including the optimization of the performance of the system. Regarding claim 6, Beelitz *et al.* teach that the subdatabases or secondary plurality of options are addressed sequentially. Beelitz *et al.* teach that the method comprises the steps of providing a user interface comprising a first list of options, receiving from the user interface an indication of a selected choice from the first list of options presented to the user via the user interface, and then generating a second list of options (see col. 2, lines 52 – 67). Regarding claim 7, Beelitz *et al.* teach that the entry for each option of the list includes an indication of compatibility with the selected operating system. Each option of the second list is compatible with the selected choice selected from the first plurality of options (see col. 2, lines 20 – 67). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate a method step wherein the compilation of a series of component equipment selections further causes the computer operating system to generate a subsequent series of inquiries regarding the choice of equipment components which are compatible or ancillary to the fluid purification system in order to provide for an optimally performing fluid purification system. Regarding

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claim 8, Chang teaches that the purification system comprises fluid flow (e.g., piping system 5), process control (e.g., sensor 56) and instrumentation equipment (e.g., heating device 21) (see col. 3, lines 36 – 67 & col. 4, lines 1 – 16). It would have been obvious to one of ordinary skill in the art to incorporate the selection of such equipment in order to facilitate the effective design and optimization of the fluid purification process. Regarding claim 9, Beelitz *et al.* teach the incorporation of cost information for indicating the cost of the particular system component part and including stock number information for indicating the number of parts in inventory (see col. 17, lines 49 – 61). Therefore, it would have been obvious to one of ordinary skill in the art to further incorporate data for evaluating from each of the responses from the user whether a defined equipment component is currently in inventory and available and if not, what the manufacturing costs would be for the particular equipment component, in order to facilitate effective fluid purification system design and optimization. Regarding claim 10, Beelitz *et al.* teach that the entry for each option of the first list includes an indication of compatibility with the selected operating system and wherein each option of the generated second list is compatible with the selected choice selected from the first plurality of options (see col. 2, lines 20 – 67 & col. 3, lines 1 – 43). Therefore, it would have been obvious to one of ordinary skill in the art to further incorporate equipment selection information, which comprises data for evaluating from each of the responses whether combinations of defined equipment components are operationally compatible and presenting an indication or notification thereof, in order to facilitate effective fluid purification system design and optimization. Regarding claims 11 and 12, Beelitz *et al.* teach the step of generating a list of compatible options based upon at least one selected choice by a user from a first list of options (see col. 2, lines 20 – 67 & col. 3, lines 1 – 43). Therefore,

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it would have been obvious to one of ordinary skill in the art to further provide a notification including a suggested list of options for alternative compatible equipment combinations for the system, in order to provide for the effective design and optimization of the fluid purification system. Regarding claim 13, it is considered a latent property that each of the different equipment combinations would have differ from each other with respect to technical parameters, such as required flow rate and operating pressure, and economic parameters, such as manufacturing and operating cost. It would have been obvious to one of ordinary skill in the art to incorporate different combinations of equipment, which differ with respect to technical and economic parameters, and wherein the method further comprises the step of generating a further inquiry, in which the response to the inquiry indicates a selection among the equipment combinations a specific equipment combination having the technical and economic parameters most suitable for obtaining an optimized fluid purification within the fluid purification system, in order to provide for an optimized fluid purification process. Regarding claim 15, Chang does teach the use of filtering during fluid purification and recovery (see col. 4, lines 10 – 16). The removal of contaminants to a prescribed level in a parts per million or parts per billion range is considered a latent property of the disclosed fluid purification system. It would have been obvious to one of ordinary skill in the art to incorporate the use of an operating parameter, such as a prescribed contaminant level, in order to properly design and optimize the fluid purification process. Regarding claim 16, Chang teaches that the purification process comprises separation or filtration (see Abstract). Regarding claim 17, Beelitz *et al.* teach that access to the system is provided by means of a computer through a global computer network, such as the internet (see Abstract). Regarding claims 18 – 27, Beelitz *et al.* teach the computer system-based apparatus,

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as recited in the instant claims, for performing the claimed method. Regarding claims 18 and 19, Beelitz *et al.* teach an apparatus comprising an electronic media, which can comprise the claimed method in a form accessible for interactive use, such as in the form of a software program, and further comprising a relational database (see col. 2, lines 9 – 51). Regarding claims 20 – 22, Beelitz *et al.* teach that the relational database may comprise a plurality of subdatabases, such as a secondary plurality of option listings. It would have been obvious to one of ordinary skill in the art to utilize the computer system, as taught by Beelitz *et al.*, in implementing the method, as taught by Chang in view of Beelitz *et al.*, since these computer systems are notoriously well known in the art for implementing such methods, as evidenced by Beelitz *et al.* Regarding claims 23 and 24, Beelitz *et al.* teach that the computer system incorporates the use of an interactive storage media, such as a memory hard drive, CD-ROM drive or a DVD drive, disposed within the computer system (see col. 1, lines 36 – 55). Regarding claim 25, Beelitz *et al.* teach that the computer system comprises a desktop computer, a portable notebook or laptop computer, or an internet-access-specific computer (see col. 1, lines 36 – 55). Regarding claims 26 and 27, Beelitz *et al.* teach that the electronic media comprises a global computer network, such as a computer system having access to a communications network and to the internet (see col. 1, lines 36 – 55; & col. 3, lines 32 – 43). The use of internet websites in conducting commercial transactions are notoriously well known in the art.

Response to Arguments

Applicant's arguments filed 2/20/2004 have been fully considered but they are not persuasive.

The applicant essentially asserts that the Beelitz *et al.* methodology is incompatible for use with the applicant's methodology of identifying fluid purification equipment, which is optimized for use in a particular fluid purification system. The applicant alleges that the fact that a set of selected components may be "compatible" for implementation on a target computer system does not necessarily mean that the resulting system is capable of satisfying the desired operating parameters. Contrary to these allegations by the applicant, Beelitz *et al.* teach that a computer system is configured to satisfy certain desired operating parameters selected by the user. For example, Beelitz *et al.* teach that the system presents a list of a first plurality of options or parameters for selection by the user. Based upon which parameters are selected, the system generates a second plurality of options, which are compatible with the first selected option (see col. 2, lines 20 – 67). The applicant further alleges that in the disclosure of Beelitz *et al.*, the user must have knowledge that the particular selection of components will yield the desired operating parameters that are expected of the desired computer system. Contrary to this allegation, Beelitz *et al.* teach that only compatible choices are presented to the user during the component selection process. Beelitz *et al.* teach that the user does not have to be sophisticated in the language of computer equipment or computer software programs to be able to specify and/or order a build-to-order computer system (see col. 3, lines 26 – 42). Therefore, contrary to the assertions of the applicant, a user does not have to have specific knowledge that the particular selection of equipment components will yield the desired operating parameters that are expected of the desired computer system, since these equipment components are presented to the user.

In response to applicant's argument that Beelitz *et al.* involve non-analogous art relative to the teachings of Chang and Hansen *et al.*, it has been held that a prior art reference must either

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be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, **the Courts have held that "[a] reference is reasonably pertinent if, even though it may be in a different field of endeavor, it is one which, because of the subject matter with which it deals logically would have commended itself to an inventor's attention in considering his problem."** (emphasis added). See *In re Clay*, 23 USPQ2d 1058 (CAFC 1992); & *In re GPAC, Inc.*, 35 USPQ2d 1116 (Fed. Cir. 1995). **If a reference disclosure relates to the same problem as that addressed by the claimed invention, "that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention."** *Id.* (emphasis added). In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference, but also the inferences, which one skilled in the art would reasonably be expected to draw therefrom. See *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1986). The applicant is advised that the Courts have held that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)). However, the "suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all the references used to show obviousness." See *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985). Rather, the test is whether the combined teachings of the prior

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art, taken as a whole, would have rendered the claimed invention obvious to one of ordinary skill in the art. See *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The Courts have held that “[t]here are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 & 1458 (Fed. Cir. 1998) (see MPEP § 2143.01). The *Beelitz et al.* reference relates effectively to the same problem and solution as that addressed by the claimed invention. Hence, one of ordinary skill in the art would have recognized the suitability of applying the same or similar method, as disclosed by *Beelitz et al.*, incorporating the use of relational databases and an interactive interface, for the same intended purpose of configuring, building and selling a similarly customizable product, such as a fluid purification system, as taught by Chang (see MPEP § 2144.07). Furthermore, one of ordinary skill in the art would have had a reasonable expectation of success in applying the methodology, as taught and effectively demonstrated by *Beelitz et al.*, in the configuring and selling of a customizable fluid purification system (see MPEP § 2143.02). The Courts have held that the prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the Courts have held that to provide an automatic or mechanical means to replace manual activity, which accomplishes the same result, is within the ambit of one of ordinary skill in the art. See *In re Venner*, 120 USPQ 192 (CCPA 1958). The use of such a computer system-based method, as taught by Chang in view of *Beelitz et al.*, merely substitutes or replaces a manual methodology of consulting print references, such as operating manuals or equipment catalogs, in process

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design and optimization, which are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide a method for identifying fluid purification equipment, which is optimized for use in a particular fluid purification system, wherein the method comprises the steps of: providing a relational database of equipment specifications regarding a plurality of equipment components from which a selection of individual components may be made; providing access to the relational database through an interactive interface of an operating system comprising a series of sequential inquiries, wherein the response to each determines the next type of inquiry to be posed or a component to be specified, wherein the inquiries elicit defining information regarding the particular fluid purification system; and using the defining information to identify those equipment components specific to the particular fluid purification system selected, can be operated so as to optimize the selected fluid purification system, in order to provide an effective method for identifying fluid purification equipment for an optimized fluid purification system.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Sines, Ph.D. whose telephone number is (571) 272-1263. The examiner can normally be reached on Monday - Friday (11:30 AM - 8 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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